

Remarks/Arguments

Claims 1-6 are pending in the application. Reconsideration and allowance of claims 1-6 in view of the following remarks is respectfully requested.

The rejection of claims 1-6 under 35 U.S.C. § 103:

Claims 1-6 stand as rejected as being obvious in view of Stetman, et al. (U.S. Pat. No. 5,176,623) in view of DiGiulio (U.S. Pat. No. 4,088,129); claim 6 further stands rejected as obvious in view of Stetman and DiGiulio and further in view of Kowalczyk, et al. (U.S. Pat. No. 6,406,450 B1).

Applicant disagrees with the Examiner's conclusion and traverses the rejection for the following reasons. First, the Examiner has not established a prima facie case of obviousness because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references or to combine the referenced teachings as suggested. Second, the Examiner has also failed to establish a prima facie case of obviousness since the prior art references do not teach or suggest all of the claim limitations.

An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in

the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and

particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

Specifically, independent claim 1 requires, in part, an ankle fracture brace having "a pair of spaced vertical arms connected by arm lower ends to sides of the foot support portion so as to extend upwardly past sides of ankle of a patient and terminating adjacent sides of a calf of a patient ... and a horizontal break line in each of the arms between the upper end and the lower end strap for selectively severing the arms on the brake lines to accommodate different patient uses of the ankle brace. At paragraph 5, the Examiner has acknowledged that Stetman, does not disclose a horizontal break line in each of the arms between the upper end and lower end straps; however, in paragraph 6 the Examiner has stated that DiGiulio teaches providing a scored bar that can be broken manually by the application of bending movement to provide a shorter bar having one of a number of predetermined discrete lengths. In paragraph 7, the Examiner argues that therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the supporting arms of Stetman, in view of DiGiulio to provide a horizontal break line in each of the arms between the upper end and lower end straps which can be broken off for the purpose of accommodating different patient uses of the ankle brace. Applicant cannot agree. First, while DiGiulio provides motivation for varying the length between patient's feet for "abduction braces" for holding the feet of a patient at fixed distances from each other while performing a corrective function, DiGiulio does not teach or suggest varying the effective height of

an ankle brace. Similarly, while Stetman discloses an ankle orthopedic appliance, Applicant finds no disclosure in Stetman that it would be desirable or advantageous to provide for a modifiable height to the ankle orthopedic appliance of Stetman. With DiGiulio only teaching the advantages of varying the distance between feet, and Stetman providing no motivation for varying the height of an ankle orthopedic appliance, Applicant asserts there is not motivation for modifying Stetman to provide a ankle orthopedic appliance with variable height capability. Accordingly, Applicant submits there is no motivation or suggestion in the references themselves to modify the references as suggested.

Second, a combination of Stetman and DiGiulio would not result in the invention as claimed. Specifically, Applicant submits that a combination of the technology of DiGiulio with Stetman would result in a device having a right and left ankle orthopedic appliance as shown in Stetman with an abduction brace adapted to be connected between the right and left ankle orthopedic appliances to hold the feet at a distance from each other while performing a corrective function, as is disclosed in DiGiulio. Such a device would have a modifiable length between the right and left ankle orthopedic appliances, but would not provide for horizontal break lines in each of the arms between the upper end and lower end straps, as recited in Applicant's independent claim 1. Accordingly, Applicant submits that a combination of these references would not meet all of the limitations cited in independent claim 1.

Third, dependent claim 2 recites that the "laterally spaced horizontal break lines are located in each of the arms on both inner and outer surfaces thereof." At paragraph 8, the Examiner has stated that Stetman does not disclose laterally spaced horizontal break lines located in each of the arms on both inner and outer surfaces thereof; however, the Examiner has argued at

paragraph 9 that DiGiulio teaches scoring lines achieved by the formation of the dashed-shaped notches being opposed in pairs on opposite sides of a bar. The Examiner reasons that therefore it would have been obvious to one of ordinary skill in the art to modify the vertical arms of Stetman, et al., in view of DiGiulio to provide laterally spaced horizontal break lines that are located in each of the arms on both inner and outer surfaces thereof. Applicant cannot agree. Specifically, even if DiGiulio and Stetman were combined, there is not teaching or suggestion that the V-shaped notches of DiGiulio be positioned on the "inner and outer surfaces" as recited in Applicant's claim 2, as opposed to front and back surfaces of leg supports 14 of Stetman. Without such specific teaching, Applicant believes that the rejection cannot be maintained. Further, Applicant believes that even were V-shaped notches provided on the leg supports 14 of Stetman, one of ordinary skill in the art would be motivated to place these V-shaped notches on the front and back surfaces thereof to limit contact between the V-shaped notches and the leg of a user, contrary to the device described in Applicant's claim 2. Accordingly, Applicant submits there is not motivation or suggestion to combine the references as suggested. Accordingly, Applicant submits dependent claim 2 is novel and not obvious in view of the proposed combination.

Conclusion:

In view of the above amendments and remarks, Applicant believes that claims 1-6 are in condition for allowance, and Applicant respectfully requests allowance of such claims. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515-558-0200.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request

for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJZ', with a long horizontal line extending to the left.

TIMOTHY J. ZARLEY
Reg. No. 45,253
ZARLEY LAW FIRM
Capital Square
400 Locust Street, Suite 200
Des Moines, Iowa 50309
Phone No. 515-558-0200
Fax No. 515-558-7790

Attorney of Record

TJZ/JJL/kc